



PATENT

**In the United States Patent and Trademark Office
Before the Board of Patent Appeals and Interferences**

In re application of: Walter M. Bain

Serial Number: 10/755,849

Filed: January 12, 2004

Art Unit: 3653

Examiner: Jeffrey A. Shapiro

For: Automated Prescription
Dispensing System and
Method of Use

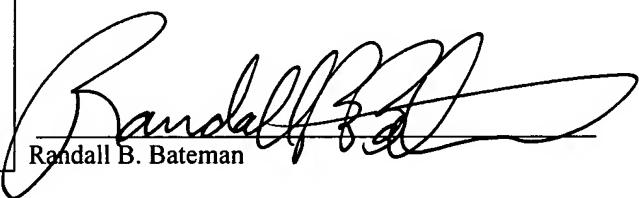
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Randall B. Bateman

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria VA, 22313, 1450

Attention: Board of Patent Appeals and Interferences

Sirs:

This brief is submitted in the format of 37 C.F.R. § 41.37(c) and 41.41 and MPEP §

1208:

(1) REAL PARTY IN INTEREST

The real party in interest in the present pending appeal is Distributed Delivery Networks, Inc., the assignee of the above-referenced application.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals, interferences, or litigation.

(3) STATUS OF THE CLAIMS

Claims 60-112 are pending. Claims 1-59 have been canceled.

Claims 60-112 stand rejected.

The rejection of claims 60-112 is appealed.

(4) STATUS OF AMENDMENTS

The last amendment was filed on April 25, 2006, and was responsive to the Final Office Action of March 6, 2006, and the Advisory Action of April 11, 2006. The April 25, 2006 Amendment was entered for purposes of appeal pursuant to the Advisory Action of May 18, 2006.

(5) SUMMARY OF THE INVENTION AND OF CLAIMED SUBJECT MATTER

The summary of the invention and of claimed subject matter contained in the Appeal Brief is correct.

(6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

(A) Whether claims 60-80, 93 and 95-112 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams et al. (U.S. Pat. No. 5,597,995) in view of Schlamp (U.S. Pat. No. 5,385,265) and further in view of Liff et al. (U.S. Pat. No. 5,713,485).

(B) Whether claims 81-94 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams et al. in view of Schlamp.

(7) ARGUMENT

I. THE CLAIMS ARE PATENTABLE OVER 35 U.S.C. § 112.

In the Examiner's Answer, the Examiner raises an objection to claim 61 as being under 35 U.S.C. § 112, ¶ 2. Applicant respectfully notes that Applicant's Appeal Brief inadvertently left out one of the amendments made to Claim 61 in Applicant's Amendment After Final filed April 25, 2006. The amendment was entered by the Examiner's Advisory Action dated May 18, 2006. The element cited as raising the concern under section 112 was amended as follows:

61. (Currently Amended) . . .

storing electronically, via a the control portion, information corresponding to the plurality of patients and sufficient to identify each of the plurality of patients;

Thus, Applicant submits that the claim, as it currently stands, is proper under 35 U.S.C. § 112 and the rejection should be withdrawn. Applicant has included a Revised Appendix A to include claim 61 as amended in the April 25, 2006 Amendment.

II. THE EXAMINER HAS FAILED TO MAKE OUT A *PRIMA FACIE* CASE OF OBVIOUSNESS IN ACCORDANCE WITH 35 U.S.C. § 103 and *GRAHAM V. JOHN DEERE*.

Applicant respectfully submits that the Examiner has failed to meet the requirements of 35 U.S.C. § 103 and those expressed by the Supreme Court in *Graham v John Deere*, as they relate to a *prima facie* case of obviousness.

The initial burden of presenting a *prima facie* case of obviousness rests with the Examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). It is impermissible to conclude that an invention is obvious based solely on what the Examiner considers to be basic knowledge or common sense rather than evidence in the record. *See In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1613, 1697 (Fed. Cir. 2001). Thus, the burden is on the Examiner to identify substantial evidence in the record to support his conclusion that it would have been obvious to combine the cited prior art in such a way as to achieve the claimed invention. *See In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

35 U.S.C. § 103 provides that “[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the *differences* between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious *at the time the invention was made* to a person having ordinary skill *in the art to which said subject matter pertains*.” (Emphasis added).

The U.S. Supreme Court has explained that in evaluating the obviousness of an invention under 35 U.S.C. § 103, “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” *Graham v. John Deere Co. of Kansas City*, 86 S.Ct. 684 (1966).

Moreover, the test of obviousness requires one to consider the invention as a whole in light of all of the references in their entireties, *See Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983), and not to pick and chose from the prior art absent a motivation to combine. *In re Fine*, 837 F.2d 1071, 1075; 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). The latter approach, commonly referred to as hindsight reconstruction, has been repeatedly rejected by the Courts. *Id.* at 1598.

In the present case, the Examiner has not performed the requisite analysis under Section 103 or *Graham* in determining the patentability of the claims in question. Primarily, the Examiner has failed to define the person of skill in the relevant field of art; has not considered the scope and content of the prior art as a whole; and has not analyzed the differences between the prior art and the invention in light of this relevant level of skill. Furthermore, the Examiner has disregarded substantial non-patent evidence which suggests that it would not have been obvious to distribute pharmacy filled prescriptions through an automated dispensing system directly to patients. For each of these reasons, the pending claims should be found patentable.

- A. The person of skill in the art is one experienced in handling prescription medication, such as a pharmacist, pharmacy technician, or person experienced in pharmaceutical distribution.

Graham and Section 103 are clear that the determination of obviousness is taken in light of a person who is skilled *in the art to which said subject matter pertains*. The present application involves improvement to the process of delivering pharmacy filled prescriptions to patients. This is the field of art. Thus, for the present application, a person having ordinary skill in the art to which the subject matter pertains is a pharmacist or pharmacy technician skilled in the preparation of filled prescriptions and the delivery of these prescriptions to patients at the pharmacy, and persons experienced otherwise experienced in pharmaceutical delivery.

Further, Section 103 clarifies that the requisite level of skill is determined as of the time the invention was made. The application in question has a priority date of September 6, 2000, and the invention was made before that date. Thus, the relevant person of skill is a pharmacist or pharmacy technician who, in the early part of the year 2000, was skilled in delivering prescriptions to patients. The Examiner provides no contrary definition as to one of ordinary skill in the art.

The level of skill in the art is important because it sets the point of reference for determining to what art one would look to determine if an invention was obvious. The delivery of pharmaceuticals and controlled substances is highly regulated both by federal and state laws. States have Pharmacy Boards that set the requirements both for those working in the pharmacy and how they must control dispensing of the medications. In many states, a pharmacist must have a doctoral degree. If a patient gets the wrong medication, or is instructed improperly, serious injury or death may result. Thus, a pharmacy is, without hyperbole, an environment where any transaction could have a life or death impact.

Placed in this setting, the scope of prior art which one of ordinary skill in the art would look to is narrower than might be had in another environment where one was simply attempting to automate some step of a process.

- B. The Examiner has failed to consider the scope and content of the prior art as a whole, as the art provides no showing that a pharmacist, etc. would have incorporated a device such as the Schlamp device into a pharmacy.

When considered as a whole, the record of pharmacy patents demonstrates that it was not obvious to a pharmacist or person skilled in improving the efficiency and accessibility of a pharmacy to incorporate a vending device such as the Schlamp device into a pharmacy. The pharmacy patents filed before Applicant's invention show that a pharmacist, etc. did not look to

incorporate vending machines into a pharmacy, but attempted to improve the process of filling and preparing prescriptions or developed remote miniature dispensing kiosks to allow some patients to avoid the pharmacy altogether. The prior art pharmacy patents filed after Applicant's invention demonstrate nonobviousness as they show that many inventors who were previously involved in developing prescription filling stations or remote kiosks adopted Applicant's technology and began to develop and seek patent protection for dispensing systems similar to Applicant's system.

1. The prior art pharmacy patents filed before Applicant's invention show that a pharmacist, etc. did not look to incorporate vending machines such as the Schlamp device into a pharmacy to deliver pharmacy filled prescriptions to patients.

The abundance of patents dealing with processes and systems for improving efficiency in pharmacies demonstrates that pharmacists and others knowledgeable in the pharmacy trade were looking for ways to improve the efficiency of pharmacies and the availability of medicine over the last two to three decades. It is well recognized in the pharmacy trade that there are problems in the way that pharmacies currently operate. Thus, skilled artisans in this trade have worked to improve the speed and accuracy of preparing and delivering prescriptions to patients and to improve patient access to the pharmacy. There are many patents which are directed towards improving the pharmacy. These patents show the knowledge and understanding of those persons skilled in the pharmacy art.

The pharmacy patent record, however, does not provide support for the view that those skilled in the pharmacy arts would look to vending machines as suitable for improving the efficiency of the pharmacy and improving patient access to medication. In the Appeal Brief, Applicant summarizes the prior art patents which are directed towards improving the accuracy, efficiency, and accessibility of the pharmacy. These patents show that many skilled in the

pharmacy trade viewed the potential solutions as falling into two major groups: improving the speed and accuracy of the bottle filling and labeling process to fill the prescriptions, or substituting a self-contained kiosk for the pharmacy.

The patents aimed at improving the speed and accuracy of filling prescriptions desired to eliminate errors in the filling of prescriptions and reduce the time spent by the pharmacist in filling prescriptions by utilizing computers and machines to aid in the preparation of prescriptions. Williams, on which the Examiner relies, is such a system. By reducing the time spent by the pharmacist in filling prescriptions, the pharmacist has more time for counseling patients.

The patents directed towards self-contained pharmacy kiosks provide kiosks which could be installed at remote location, such as in a doctor's office, in lieu of a pharmacy. (See Rosenblum, U.S. Patent No. 6,529,801, Col. 1, lines 45-50). The kiosks would contain a relatively small number of commonly used drugs available in prepackaged containers (or containers loaded by the kiosk) in commonly needed quantities. A patient needing such a prescription could have the prescription sent to one of these kiosks at the doctor's office and then go to the kiosk to retrieve the medicine the doctor prescribed.

The kiosk devices would divert many patients from accessing a conventional pharmacy all together, and thus reduce the pharmacist's workload. They are limited, however, because they may only hold a small number of different medications, such as one hundred medications, while a pharmacy may typically carry 2,000-3,000 different medications.

The record of prior art pharmacy patents shows that those skilled in the pharmacy trade worked on improving the efficiency and accessibility of the pharmacy for decades before Applicant's invention. The extensive history of patents directed towards improving the

efficiency and accessibility of the pharmacy significantly reduces any speculation necessary to determine the understanding of a person skilled in the pharmacy trade as it provides a clear disclosure of what one skilled in the pharmacy trade understood at the time preceding Applicant's invention. These patents provide a specific understanding of what persons skilled in the pharmacy trade viewed as desirable changes to the pharmacy, desirable results to achieve, and suitable methods to achieve those changes and results.

These pharmacy patents do not show or suggest the use of an automated dispenser to receive pharmacist filled prescriptions and dispense these to patents as taught and claimed by Applicant. These patents show that those skilled in the pharmacy trade viewed other methods and systems as being appropriate for improving the pharmacy. Rather than consider the present invention in light of the understanding of these skilled artisans, the Examiner would improperly dismiss the pharmacy patent record as merely "a litany of prior art references." *Examiner's Answer* at page 15. However, this is all there really is to show the understanding of one of skill in the art at the time the invention was made.

The Examiner makes no showing that, at the time of the invention, one of skill in the art had considered the advantages of a pharmacist filling a prescription and then utilizing an automated dispensing machine to deliver the medications to the patient, or considered the modifications which would necessarily be made to a vending machine to allow it to safely and efficiently function in such a manner. In fact, the motivations used by the Examiner to support the combination of Schlamp and Williams are drawn right out of Applicant's disclosure. It is well established that an Examiner may not rely on the teachings of the Applicant to provide motivation to combine references. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) ("the very ease with which the invention can be understood may prompt one to 'to fall victim to

the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher’.”). The Examiner, however, is forced to rely on such motivations, because they are simply not present in the prior art.

Moreover, the Examiner attempts to provide motivations to combine Schlamp and Williams by creating advantages which are not taught in either reference. Ironically, the cited motivations actually teach away from the cited references. For example, the Examiner asserts that one would be motivated to replace the conventional will call area of Williams with the automated dispenser of Schlamp to save space. The result would have the exact opposite effect. Williams, a pharmacy, needs a conventional will call area to provide patients their prescription. Adding Schlamp would only add to the space requirement for the pharmacy.

The Examiner’s answer demonstrates why it is critical to properly compare the invention and prior art in light of the understanding of one of skill in the art to which the invention pertains. The Examiner states that it would be obvious to place the Schlamp device in a pharmacy to achieve Applicant’s invention because the device is “much like a cooled dairy freezer in a supermarket, in which the merchant loads the milk from the inside, and the customer opens the door from the outside to remove the milk.” *Ex. Answer.* at 12.

This reasoning supports the patentability of Applicant’s invention. The fact that pharmacists have been aware of and used dairy freezers for decades yet never saw fit to incorporate one into a pharmacy suggests that it was not obvious or proper to do so. Furthermore, it must be appreciated that if one were to place such a dairy freezer into a pharmacy, the pharmacist would lose control over which prescription is picked up by a customer, just as supermarket customers may choose any bottle of milk. The improper use of prescriptions may have serious adverse health effects, and a dairy freezer simply does not provide appropriate

control to be used for dispensing prescriptions. The Examiner's faulty analogy demonstrates why it is critical to view the problem through the eyes of one skilled in the pharmacy trade.

The abundance of patents in the pharmaceutical dispensing area demonstrates that those skilled in the art did not look to such a methodology for dispensing prescriptions. The prior art and other evidence does not show any teaching to place an automated dispensing system as claimed into a pharmacy despite the abundance of inventions attempting to improve the prescription filling process. This evidence also provides no teaching to modify the Schlamp device to function as claimed and place that device into a pharmacy. The claims under appeal are thus patentable, as the prior art record and supplemental evidence shows that it was not obvious to place a vending device such as Schlamp in a pharmacy to those skilled in the pharmacy trade.

2. The prior art pharmacy patents filed after Applicant's invention demonstrate nonobviousness where many inventors involved in improving the pharmacy adopted Applicant's technology.

Rather than rendering Applicant's invention obvious, the abundance of pharmacy patents show that, at the time of the invention, Applicant's invention was not obvious to persons skilled in art of delivering prescription medications. Numerous inventive entities were attempting to improve the delivery of medications. None of them, however, suggested the invention conceived of by Applicant.

The record of pharmacy patents filed after the publication of Applicant's application further supports the patentability of the pending claims in that it shows that many persons skilled in improving the efficiency and accessibility of the pharmacy adopted the technology disclosed in Applicant's application after the public disclosure of Applicant's invention. These persons were not new converts to the business of improving the pharmacy. To the contrary, each of the

inventive entities which have now filed patent applications for methods and systems of dispensing pharmacy filled prescriptions includes inventors experienced in pharmacy automation.

These inventors had developed and patented alternate solutions prior to the publication of Applicant's invention, and made wholesale changes to their equipment and methodologies to adopt Applicant's technology and seek to patent methods similar to Applicant's method after Applicant's invention became public.

Applicant, Walter Bain is a pharmacist and was the first to conceive of the dispensing of filled prescriptions through an automated dispenser. After Bain's invention became public in 2000 and was published in a PCT application in 2001, three other groups filed patent applications to claim systems where a pharmacist fills a prescription which is then dispensed to a patient in an automated dispensing system.

For example, Ken Rosenblum, a physician, has several patents which relate to kiosk prescription dispensers. A few months before the filing date of Applicant's application, Dr. Rosenblum filed a patent application for a prescription dispensing kiosk that could be placed in a doctor's office. Dr. Rosenblum obtained several patents for his dispensing system (See U.S. Patent Nos. 6,766,218; 6,697,704 and 6,529,801). Nearly two years after the filing date of Applicant's initial application, Dr. Rosenblum took a remarkable turn in methodology. He filed a continuation-in-part application and modified his device so that it could be used in a pharmacy and could receive pharmacist filled prescriptions. Not only did Dr. Rosenblum disclose such a system, a number of the claims in U.S. Patent No. 6,892,941 are specifically drawn to the use of an automated dispensing system for delivering pharmacist filled prescriptions directly to a patient. (See e.g. Claims 3 and 8).

Dr. Rosenblum is not the only inventive entity to adopt Applicant's invention. Linda Pinney is a former employee of Pyxis, a company which makes automation systems for drug delivery. Ms. Pinney and her co-inventors have obtained a number of patents including U.S. Patent Nos. 5,520,450 and 5,346,297. Nearly three years after Applicant's initial filing date, Pinney et al. took a marked turn from their previous inventions and filed a provisional patent application seeking to patent the automated dispensing of pharmacist filled prescription. Pinney et al. were successful and now own U.S. Patent No. 7,123,989, which claims the automated vending of a pharmacist filled prescription.

Still others have changed their approach to improving a pharmacy since the public disclosure of Applicant's invention. Baker et al. (affiliated with Distributed Delivery Networks) currently has two patent applications pending for automated systems for dispensing pharmacy filed prescriptions, 10/830,365 and 10/927,167. This is a markedly different approach from the prior approaches at improving medicine delivery patented by members of this inventive entity, such as the patents awarded to co-inventor William Holmes. (U.S. Patent Nos. 6,109,774; 6,065,819 and 5,661,978).

Yet, it was not until two years after Applicant filed his patent application and began installations of his prototype that each of these inventive entities changed course and began inventing automated machines for dispensing pharmacist filled prescriptions.

Rosenblum shifted his focus from machines that would replace the pharmacy to machines that would dispense a pharmacist filled prescription. Pinney et al. and Baker et al. shifted their focus from back end bottle filling and prescription handling to automated dispensing machines. In fact, Distributed Delivery Networks (Baker et al.) purchased the rights to Applicant's invention. Thus, prior to Applicant's invention, no one suggested having a pharmacist fill the

prescription and then having a machine dispense the filled prescription directly to a patient.

Since Applicant's invention, several companies have adopted the technology

The Examiner attempts to dismiss this evidence as mere copying and gives it little weight. The fact, however, that at least these three competitors have changed course and adopted Applicant's approach to improve the prescription filling process strongly suggests that it was not obvious to do so prior to Applicant's disclosure. Thus, the Examiner's hindsight reconstruction in support of obviousness is simply overwhelmed by the facts that demonstrate that it was not obvious in 2000 to use an automated dispensing system to dispense pharmacist filled prescriptions.

The supplemental evidence submitted by Applicant further demonstrates that Applicant's invention was viewed as a revolutionary change in the field of pharmacy. Applicant has submitted additional evidence such as the commercial success and interest in the product, unsolicited media coverage of the product, and additional evidence of competing products which were developed after the disclosure of Applicant's device. This supplemental evidence is in agreement with the pharmacy patent record in showing that Applicant's invention was not obvious at the time of invention, and was truly a revolutionary change in the way persons skilled in the improvement of pharmacies

- C. The Examiner has not properly examined the claims as required by 35 U.S.C. § 103 and the *Graham* test.

The Examiner has not properly evaluated the differences between the prior art and the claimed invention as required by Section 103 and *Graham*. Instead, the Examiner has modified or overstated the teachings of the prior art or neglected the actual claim language to create an obviousness rejection. When viewed for its actual teachings, the prior art fails to disclose many of the claimed elements. The prior art shows that a skilled pharmacist did not view Schlamp as a

solution for improving the efficiency and accessibility of the pharmacy. Even if the combination of Schlamp with the pharmacy patents is viewed as appropriate, the references still fail to teach many of the claimed elements.

1. The Examiner has misstated the teaching of the prior art in order to achieve the elements of the claimed invention.

The Examiner has improperly rejected the claims as he has failed to analyze the differences between the prior art and the claimed invention in light of the knowledge and understanding of persons skilled in the pharmacy trade at the time that the invention was made. Section 103 and *Graham* require that the Examiner consider the differences between the prior art and the invention in light of the understanding of one skilled in the field of art to which the invention pertains. Instead of analyzing the differences between the prior art and the invention in light of the requisite skill, the Examiner has misstated and changed the teachings of the prior art

As has been discussed herein and in the Appeal Brief, there is an extensive record of pharmacy patents for inventions which specifically attempt to improve the efficiency and accessibility of the pharmacy. Rather than consider the present invention in light of the understanding of these skilled artisans, the Examiner would improperly dismiss the pharmacy patent record as merely “a litany of prior art references.” *Examiner’s Answer* at page 15. The Examiner asserts that it would be obvious to a person skilled in the pharmacy trade to disregard the pharmacy patents and instead incorporate the device of Schlamp into a pharmacy. The Examiner further modifies the device to function as claimed without any suggestion in the art to do so, and despite the pharmacy patent record’s teaching to the contrary.

The Examiner characterizes Schlamp as a pivotal reference which clearly discloses the invention. *Ex. Answer*, at page 15. It is unclear how Schlamp is such a pivotal reference when the Schlamp device is not taught as having any relevance to the pharmacy trade and does not

perform many of the functions necessary to safely and accurately dispense prescriptions, such as verifying the prescription with the patient or counseling the patient about the prescription.

The Examiner states that “[o]ne ordinarily skilled would have found that Williams provides the motivation to dispense a specific item, a drug prescription, to a customer using Schlamp’s device.” *Ex. Answer*, at page 15. Outside of this bare assertion, no support is provided. The Examiner’s assertion is simply false, as Williams provides no such motivation, but instead teaches improvement of a pharmacy by automating the prescription filling process while retaining a conventional will-call area.

Williams teaches improving the pharmacy by using a computerized and automated prescription filling system and teaches hand delivery of the prescriptions to the patients by the pharmacy staff in a conventional manner. Williams teaches that the pharmacy is improved by improving the accuracy of filling the prescriptions. Williams provides no teaching to replace the conventional will-call area with a dispenser such as the Schlamp device. To the contrary, Williams would still require a conventional will call area even if the Schlamp device were added.

The Examiner states that Schlamp discloses a dispenser “for holding items such as filled prescriptions.” *Ex. Answer* at 4. The Examiner further states that Schlamp teaches “access to a particular bin by the pharmacist to load a customer’s prescription,” “loading the filled prescriptions,” “storing information associated with the single patient sufficient to identify the single patient,” “storing the location of the filled prescription,” and “dispensing the prescription.” *Id.* at 4-5. In reality, Schlamp does not anywhere mention prescriptions, pharmacists, or patients. Schlamp does not anywhere teach loading and dispensing prescriptions. It is clear that the Examiner has not identified the *actual* teachings of Schlamp as is required by *Graham*, but rather has read the teachings of Applicant’s invention into Schlamp and then relied on the hybridized

invention to reject the claims. The overstating and modifying of the teachings of Schlamp to correspond to Applicant's invention is clearly improper.

The Examiner suggests that it would be obvious "to have added Schlamp's "will call" device to Williams pharmacy, said device allowing the loading of finished prescriptions into a merchant side of the system and allowing customer pickup on the finished prescription on the other side of the "will call" device." *Id.* at 6. This would be so only after one has read Applicant's disclosure.

Williams provides no teaching that it is desirable to replace the conventional pharmacy will-call area. Williams teaches that the pharmacy is improved by automating the prescription filling process while retaining a conventional will-call area and manually delivering prescriptions to patients. It is only Applicant's disclosure which teaches a pharmacist loading filled prescriptions into a dispenser and allowing patients to access the dispenser to retrieve the prescriptions.

The Examiner states that "it would have been obvious to allow customers to use William's dispenser after hours since the purpose of using such a dispensing device as taught by Schlamp is to save the cost and time of staffing the pharmacy continuously. See also Williams, col. 2 lines 32-38." *Id.* at 6-7. Again the Examiner is improperly drawing on the advantages disclosed in Applicant's disclosure to justify the combination and modifications thereto. There are simply no such teachings in Williams or Schlamp.

Williams does not teach a dispenser, and does not teach after hours access to the pharmacy. Williams teaches a conventional will-call area (a number of shelves or holding slots 386) which is not accessible to patients. Col. 2 lines 32-38 of Williams explain that the object of Williams is to automate the filling of prescriptions. Further, Schlamp does not make any

mention of reducing the staffing requirements of a pharmacy. Schlamp does not ever mention a pharmacy.

The Examiner states that “Williams discloses counseling the customer at col. 8 lines 42-50.” *Id.* at 7. At this paragraph, Williams actually teaches that the customer gives information to the pharmacy personnel to create a prescription order sheet. While Applicant readily admits that pharmacists have provided counsel to customers for many years, this actually teaches away from Applicant’s invention. Applicant removes the pharmacist patient interface for many customers, but frees up the pharmacist to spend more time with others. To the extent counseling is provided by Applicant, it is claimed as providing counseling to a customer about a prescription via an automated dispensing device. This is completely inconsistent with the teachings of Williams.

The Examiner states that “it would have been obvious to one of ordinary skill to have enabled Williams’ dispenser to allow communication between the patient/customer and the pharmacist or doctor through the dispenser, for the purpose of patient follow up or patient counseling.” *Id.* at 8. It is unclear how Williams’ dispenser would provide such communication and counseling since Williams’ dispenser is a number of holding slots 386. In other words, the dispenser in Williams is little more than a bookcase sized to receive prescriptions. Furthermore, the dispenser in Williams is kept behind the pharmacy counter. Thus, it is unclear how a “bookcase” behind the pharmacy counter can counsel patients or provide patient follow-up.

The Examiner states that “it would have been obvious to use sensors to detect prescriptions in each of William’s bins, as taught by Liff.” *Id.* at 10. The sensors in Liff identified by the Examiner are jam sensors 36, and do not detect the locations of prescriptions. Rather, they detect jams in the dispensing machinery. Furthermore, it is unclear why a person would add sensors to Williams’ holding slots 386 (ordinary shelves), as they would not be

jammed by placing prescriptions thereon. The extent to which the Examiner must cut and paste from the various references in order to meet the claim elements makes clear that the rejections are hindsight reconstruction and not modifications which would have been obvious to one of ordinary skill in the art.

2. Even if the combination of Williams, Schlamp, and Liff et al. is appropriate, this combination still fails to teach many claimed elements.

While Applicant believes that the combination of Williams and Schlamp or Williams, Schlamp and Liff et al. (i.e. the combination of Schlamp with the patents directed towards improving a pharmacy) are improper, numerous claims should still be allowed even if the combination was proper. The Examiner has failed to identify many of the claimed elements in the prior art. Rather, the Examiner has misstated the claims or overstated the teachings of the references to make the prior art references appear more similar to Applicant's claims. This is improper under the *Graham* test, which requires the Examiner to identify the scope and content of the prior art, identify the differences between the prior art and the claimed invention, and then evaluate whether these differences would be obvious to a person skilled in the art to which the invention pertains at the time the invention was made.

For example, the Examiner states that "Williams also discloses the "requiring of multiple pieces of information associated with a patient and verifying at least one of patient information and prescription information with the person prior to filling the prescription", as is found in several of the claims, including claim 81." *Ex. Answer* at 12. Claim 81, however, requires loading a filled prescription into an automated prescription dispenser and requiring multiple pieces of information to verify patient or prescription information prior to dispensing the

prescription to the patient. Williams does not teach an automated prescription dispenser and does not teach the method steps actually present in the claim.

Claim 66 requires that the automated dispenser provide counseling to the patient regarding the prescription. The Examiner cites to Williams at Column 8 lines 42-50 as disclosing this patient counseling. *Id.* at 7. Williams therein actually teaches the customer providing information to the pharmacy to create the prescription order sheet. The customer providing information to the pharmacy is not patient counseling. Nor is it performed by an automated dispenser.

Claim 68, 77, 93, and 112 require automatically billing an insurance provider when the prescription is retrieved. The Examiner cites Liff et al. at column 4 lines 35-36 and column 9 at lines 12-19. *Id.* at 10. Liff et al. actually teaches allowing third party payor cards may be used *at the doctor's office* (column 4) and that the device is capable of formatting third party billings for processing *by the health care provider* (column 9). Liff et al. simply does not teach automatically billing an insurance provider at the time of sale, but teaches that the doctor or health care provider bills the insurance.

Claims 69 and 81 require entry of information into an automated dispenser to identify a patient, the automated dispenser automatically verifying the prescription with the customer, and dispensing the prescription after the verification. The Examiner cites to Williams (which teaches the use of conventional will call shelves) and Schlamp (which provides no customer verification and does not discuss prescriptions) and does not provide any citation to a reference which teaches such a verification and dispensing process.

Claims 82, 83, 95, and 110 require scanning information about the prescription and sending this to the control unit of the automated dispenser and using this information to

determine the location of the prescription within the dispenser. Williams teaches the use of conventional will-call shelves in a pharmacy. Schlamp does not teach use with prescriptions, and does not teach scanning the object to store information in the automated dispenser or using scanned information to determine the location of the prescription within the dispenser.

Claims 86, 103, and 108 require using a sensor to determine if a prescription is in a holding receptacle of an automated dispenser or to verify the location of the prescription within the dispenser. The Examiner states that it would be obvious to use the sensors of Liff et al. to detect prescriptions in Williams' bins. *Id.* at 10. Williams teaches conventional will call shelves, and there is no reason to mount a sensor to the shelves, as the prescriptions are in plain view. Liff et al.'s sensors (36, Figure 1) are jam sensors, and detect when a dispensing mechanism is jammed. Clearly, there is no reason to put a jam sensor on a shelf, or to use a sensor to determine the location of prescriptions that would be plainly visible. Thus, the prior art, even if combined, does not teach the elements of the claims.

Claim 107 requires sensing the prescription with an electronic sensor to verify the location of the prescription, requiring entry of multiple pieces of information to verify the identity of the customer or prescription, verifying the prescription with the customer, and dispensing the prescription after the verification thereof. As discussed, the prior art simply does not teach any of these steps.

The Examiner would use 37 C.F.R. § 1.104(c)(2) to support the rejections, stating that the elements must be identified in the prior art "as nearly as practicable." *Id.* at 11. However, the next sentence states "The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

A complete failure to identify the elements in the prior art is not an identification thereof as nearly as is practicable, and a generic statement that the prior art teaches the claimed elements does not magically change the teachings of the prior art to include those elements. This is especially so where the Applicant has repeatedly objected to the Examiner's unsupported assertions as to where the alleged teaching is found in the prior art. This is particularly so since during prosecution, forty claims were repeatedly rejected with little more than a single paragraph.

In order to support a rejection under 35 U.S.C. § 103, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 706.02(j). Furthermore, since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP §1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application. *Id.* In the present case, there has been no showing where these elements are taught in the prior art despite Applicant's objections that the elements are simply not taught in the cited art.

- D. The Examiner has also improperly failed to give consideration to the secondary evidence provided by Applicant.

The *Graham* test also establishes that "secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc.," are "indicia of obviousness or nonobviousness." *Graham v. John Deere Co.*, 86 S.Ct. at 694. The Supreme Court further explained that these secondary considerations are "utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Id.*

The Federal Circuit has stated that it is inappropriate to disregard relevant evidence, and that "evidence rising out of the so-called "secondary considerations" must always when present

be considered en route to a determination of obviousness.” *Stratoflex, Inc., v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). The Federal Circuit explains that:

evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence. Not just when the decision maker remains in doubt after reviewing the art. *Id.* at 1538-39.

Here, the record includes both a large number of patents directed specifically towards improving the efficiency and accessibility of a pharmacy and a large number of additional evidence showing secondary considerations of nonobviousness. Importantly, the secondary evidence does not contradict the pharmacy patents, but confirms these patents showing that persons skilled in improving the efficiency and accessibility of pharmacies did not consider vending machines such as Schlamp as appropriate for use in a pharmacy as claimed.

The Examiner states that:

Despite all of the cited references and applications filed by others in this area and television interviews and reports on Appellant’s apparatus, such considerations of evidence of commercial success, fulfilling a long felt need, the failure of others to solve the problem and copying are considered to be *secondary* to the prior art which specifically discloses, teaches and suggests Appellant’s apparatus, as described in Appellant’s claims. *Ex. Answer*, at page 15.

This statement is clearly erroneous and reflects an improper disregard for the statutory and judicial requirements for examination of the invention. Initially, the statement evidences how the Examiner has ignored the teachings of “all of the cited references and applications filed by others in this area.” *Id.* This is particularly egregious as it is these pharmacy references and applications which demonstrate the understanding of those skilled in the pharmacy trade at the time of the invention, a *primary* consideration of patentability under § 103 and *Graham*. The

statement also shows a disregard for these evidences as secondary considerations of patentability.

Finally, this statement evidences an overstatement of the cited art. The prior art does not specifically disclose, teach or suggest Applicant's method. The secondary considerations show that – at the time of Applicant's invention – it was not obvious to use an automated dispensing system to dispensing pharmacy filled prescriptions directly to patients.

1. Long Felt Need

The abundance of pharmacy patents demonstrate that there is a long felt need to improve the prescription filling and dispensing process. Since long before the current shortage of pharmacists, those skilled in the art have been attempting to find ways to improve the delivery of medication to patients. Whether by speeding up the back end filling of prescriptions or by providing kiosks at doctor's offices, numerous attempts have been made to reduce the stress on the pharmacist and to provide the patient with the prescription without an extended wait. Applicant's invention fills this long felt need.

2. Failure of Others

While the inventions have improved portions of the prescription filling and dispensing process, they have failed to solve the needs which are solved by Applicant's invention. The prescription filling experience is improved for both the patient and the pharmacist. Additionally, documentation and control are enhanced, as are billing protocols. If Applicant's invention had truly been obvious, it would have been done long ago.

Significantly, none of the references of record identify the problem of how to more efficiently dispense a prescription which has been filled by a pharmacist. Failure in the art to overcome, or even identify, a significant problem solved by the claimed invention provides

objective indicia that the claimed invention was not obvious to those skilled in the art at the time of the invention. Such objective evidence of non-obviousness is significant and must be considered as part of all the evidence and operates to establish the non-obviousness of the claims. *See Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 7 U.S.P.Q.2d 1222, 1225 (Fed. Cir. 1988).

3. Copying by Others

The Examiner attempts to dismiss the adoption of Applicant's invention by Rosenblum, Pinney et al., and Baker et al. as mere copying. This is not a situation in which someone merely saw a new fungible item and decided to produce one. An automated dispensing system of Applicant's invention is highly complex and very expensive. Each of these inventive entities has experience advancing other solutions to improve the prescription filling process. Each entity, however, has changed course and adopted Applicant's invention to improve the prescription filling process.

This is not mere copying which can be dismissed out of hand. Rather, it shows that Applicant's invention was a paradigm shift. Applicant's invention presented a new way to dispense medication filled by a pharmacist that was quickly appreciated by others skilled in the art.

4. Commercial Success

The evidence of commercial success is significant. Not only are major pharmacy chains looking to install systems to practice Applicant's invention, several competitors are fighting, both in the marketplace and in the patent office, to claim the territory covered by Applicant's invention. The irony is that everyone seems to appreciate the revolutionary change advanced by Applicant's invention except the Examiner. Even the media has appreciated the advancement

created by Applicant's invention. Good Morning America, CNN Live at Daybreak, and other prominent news outlets have touted the advantages obtained by Applicant's invention. Applicant is entitled to a patent for his invention.

The Federal Circuit emphasizes the importance of "express *Graham* findings" because of the tendency "to depart from the *Graham* test , and from the statutory standard of unobviousness that it helps determine, to the tempting but forbidden zone of hindsight." *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, at 663 (Fed. Cir. 2000). The Federal Circuit further explained that hindsight is more dangerous where "the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'" *Id.* at 664. In the present case, the Examiner has engaged in hindsight reconstruction, against the weight of the prior art, and the secondary considerations of nonobviousness.

III. CONCLUSION

When one properly determines one skilled in the art and looks at the teachings of the art as a whole, it is apparent that Applicant's invention is not obvious. The pharmacy patents show that it was not obvious to use a vending device in a pharmacy to pharmacists and persons skilled in improving the pharmacy before Applicant's invention. Some of these same persons, however, rapidly adopted and pursued methods similar to Applicant's after the public disclosure of Applicant's device. When viewed as a whole, the cited patents simply fail to disclose the elements of the claimed invention. Additionally, the secondary considerations overwhelmingly demonstrate that the invention is not obvious. Thus, all of the pending claims should be allowed.

(8) CLAIMS APPENDIX

Claims 1-59 have been canceled. A copy of currently pending claims 60-112, as stand rejected and as are appealed herein, is attached as “Revised Appendix A.”

(9) EVIDENCE APPENDIX

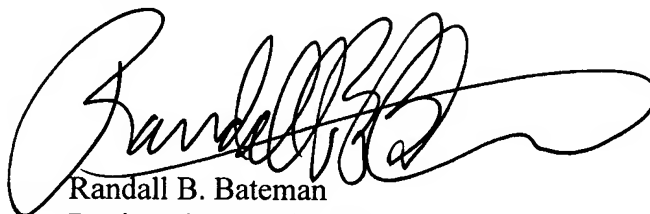
The Evidence Appendix, attached to the Revised Appeal Brief as Appendix B, is correct.

(10) RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

The commissioner is hereby authorized to charge any amount owing and to credit any overpayment to Account No. 502720.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Randall B. Bateman", with a large, sweeping flourish extending to the right.

Randall B. Bateman
Registration No. 37,774
Attorney for Applicant
8 East Broadway, Suite 550
P.O. Box 1319
Salt Lake City, Utah 84110

Tel. (801) 533-0320

Fax. (801) 533-0323

E-mail: rbb@utah-ip.com

REVISED APPENDIX A

60. (Previously Presented) A method for dispensing medication comprising:

filling a prescription by placing information unique to a single patient on a container of medication;

utilizing an automated medication dispenser, the dispenser being located in a pharmacy such that a first side of the dispenser is accessible by a pharmacy worker and such that a second side of the dispenser is accessible to the public, the dispenser having a plurality of receptacles configured for receiving filled prescriptions and having a control portion configured for operating the dispenser;

loading the filled prescription into one of the plurality of receptacles through the first side of the dispenser;

storing information associated with the single patient sufficient to identify the single patient electronically in the controller;

storing the location of the filled prescription within the dispenser via the control portion;

associating the location of the filled prescription with the information associated with the single patient in the controller;

providing access to the second side of the dispenser so as to allow a customer to input information associated with the single patient into the controller;

dispensing the prescription to the customer once the information associated with the single patient has been entered.

61. (Previously Presented) The method of claim 60, wherein the method comprises:

- filling a plurality of prescriptions for a plurality of patients by placing information unique to each of the patients on one or more containers of medication corresponding to the particular patient's prescription or prescriptions;
- loading the plurality of filled prescriptions into the plurality of receptacles, and storing electronically, via a control portion, information regarding the filled prescriptions;
- storing electronically, via the control portion, information corresponding to the plurality of patients and sufficient to identify each of the plurality of patients;
- storing the locations within the dispenser of each of the plurality of filled prescriptions in the control portion;
- associating the locations of each of the plurality of filled prescriptions with the information corresponding to the particular patient which corresponds to the particular prescription in the control portion;
- providing public access to the second side of the dispenser so as to allow a customer to input information associated with a patient into the controller;
- dispensing to the customer the filled prescription or prescriptions corresponding to a patient once information sufficient to identify the patient has been entered.

62. (Previously Presented) The method of claim 60, wherein the method further comprises selecting a medication dispenser which is disposed in a pharmacy wall.

63. (Previously Presented) The method of claim 60, wherein the first side of the medication dispenser is disposed opposite the second side of the dispenser.

64. (Previously Presented) The method of claim 60, wherein the second side of the dispenser has an opening configured for selectively allowing a customer to retrieve at least one prescription.

65. (Previously Presented) The method of claim 60, wherein the method further comprises opening one of a plurality of doors to provide access to the filled prescription.

66. (Previously Presented) The method of claim 60, wherein the method further comprises providing counseling regarding the prescription to the customer via the automated dispenser.

67. (Previously Presented) The method of claim 60, wherein the method further comprises collecting payment from the customer for the prescription.

68. (Previously Presented) The method of claim 60, wherein the method further comprises automatically billing an insurance provider for the prescription at the time of sale.

69. (Previously Presented) A method for dispensing prescriptions comprising:
transmitting at least one prescription for medication to a pharmacist;
filling the at least one prescription by preparing a container of medication bearing information specific to an identified patient;
utilizing an automated prescription dispensing machine, the machine having a plurality of receptacles configured for receiving filled prescriptions comprising labeled containers of

medication and having a control portion configured for controlling the dispensing of the filled prescriptions from the machine;

loading the at least one filled prescription into one of the plurality of receptacles;

entering the location of the at least one filled prescription, patient information, and prescription information into the control portion;

providing means whereby a customer may enter information;

automatically verifying the prescription with the customer after the customer enters sufficient information to confirm the identity of a patient; and

dispensing at least one of the at least one filled prescriptions to the customer after verification of the prescription.

70. (Previously Presented) The method of claim 69, wherein the method further comprises:

transmitting a plurality of prescriptions for medication to a pharmacist;

filling a plurality of prescriptions;

loading each of the plurality of filled prescriptions into receptacles of the plurality of receptacles;

entering for each of the plurality of filled prescriptions the location of the filled prescription and patient information; and

dispensing to a customer one or more of the plurality of filled prescriptions corresponding to a single patient in response to the entry of information sufficient to identify the patient into the dispenser.

71. (Previously Presented) The method of claim 69, wherein the method further comprises charging the customer for the dispensed filled prescription.

72. (Previously Presented) The method of claim 69, wherein the dispensing machine is located in a pharmacy wall.

73. (Previously Presented) The method of claim 69, wherein the method further comprises having pharmacy staff load the filled prescription into the dispensing machine.

74. (Previously Presented) The method of claim 69, wherein the method further comprises allowing customers to receive prescriptions from the dispensing machine after the pharmacy is closed.

75. (Previously Presented) A method for dispensing prescription medication comprising:
receiving a plurality of written or electronic prescriptions for medication corresponding to a plurality of different patients at a pharmacy;

filling the plurality of prescriptions by preparing containers of medication having information specific to an identified patient thereon;

utilizing an automated medication dispenser which is accessible to the public, the dispenser having a plurality of receptacles configured for receiving a plurality of filled prescriptions, and having a control portion for controlling the dispensing of medication from the dispenser;

loading the plurality of filled prescriptions in the plurality of receptacles;

entering the location of each of the plurality of filled prescriptions and information associated with each patient of the plurality of different patients into the control portion;

correlating the location of each of the plurality of filled prescriptions to the information entered for the corresponding patient;

receiving at least two pieces of information from a customer and verifying whether the information entered properly identifies a patient corresponding to a filled prescription which is stored in the dispenser; and

dispensing a filled prescription from the dispenser in response to entry of information by a customer which corresponds to that prescription and to the patient.

76. (Previously Presented) The method of claim 75, wherein then method further comprises charging the customer for at least a part of the cost of the prescription.

77. (Previously Presented) The method of claim 75, wherein the method further comprises automatically billing an insurance company for at least a part of the prescription, at the time of sale.

78. (Previously Presented) The method of claim 75, wherein method comprises dispensing the filled prescription via an opening so that it is accessible by the customer.

79. (Previously Presented) The method of claim 75, wherein the method further comprises providing a plurality of doors in communication with the plurality of receptacles and

selectively actuating one of the plurality of doors after the patient enters sufficient information to identify the patient.

80. (Previously Presented) The method of claim 75, wherein the method further comprises selectively releasing from one of the plurality of receptacles a filled prescription corresponding to a customer after the customer enters information sufficient to identify and provide authorization of a patient so as to allow the customer to retrieve the prescription.

81. (Previously Presented) A method for dispensing filled prescriptions, the method comprising:

filling a prescription by preparing a container of medication with a label bearing patient information;

loading the filled prescription into an automated prescription dispensing system disposed so as to be accessible from both sides of a pharmacy wall, one side inside the pharmacy being configured for loading prescriptions into the automated prescription dispensing system, and another side being configured for dispensing the filled prescription to the public on the opposing side of the pharmacy wall; and

dispensing the filled prescription to a customer outside the pharmacy wall in response to information input by a person;

wherein the method further comprises requiring multiple pieces of information associated with a patient and verifying at least one of patient information and prescription information with the person prior to dispensing the filled prescription.

82. (Previously Presented) A method for dispensing filled prescriptions, the method comprising:

filling a prescription by preparing a container of medication with a label bearing patient information;

loading the filled prescription into an automated prescription dispensing system disposed so as to be accessible from both sides of a pharmacy wall, one side inside the pharmacy being configured for loading prescriptions into the automated prescription dispensing system, and another side being configured for dispensing the filled prescription to the public on the opposing side of the pharmacy wall; and

dispensing the filled prescription to a customer outside the pharmacy wall in response to information input by a person;

wherein the method comprises scanning information about the filled prescription and sending the information to a control unit.

83. (Previously Presented) The method according to claim 82, wherein the method further comprises utilizing the scanned information to determine the location of the filled prescription within the automated prescription dispensing system.

84. (Previously Presented) The method according to claim 81, wherein the method comprises utilizing information input by the customer into a control unit and dispensing the filled prescription to the person when adequate information has been received to verify that the customer has authorization to pick-up the filled prescription.

85. (Previously Presented) The method according to claim 81, wherein the method comprises placing the filled prescription in a medication holding receptacle and correlating which medication holding receptacle holds the filled prescription with information correlated with the patient.

86. (Previously Presented) The method according to claim 85, wherein the method comprises using a sensor to determine if a filled prescription is in a medication holding receptacle.

87. (Previously Presented) The method according to claim 81, wherein the method comprises selectively closing at least one door on the side of the automated prescription dispensing system in which filled prescriptions are loaded to selectively limit access to the filled prescriptions.

88. (Previously Presented) The method according to claim 87, wherein the method comprises providing a plurality of doors disposed adjacent medication holding receptacles and where the doors selectively inhibit dispensing filled prescriptions from the medication holding receptacles.

89. (Previously Presented) The method according to claim 81, wherein the method comprises disposing a plurality of filled prescriptions in a single medication holding receptacle.

90. (Previously Presented) The method according to claim 89, wherein the method comprises dispensing the plurality of filled prescriptions in response to information input by a customer and associated with a patient.

91. (Previously Presented) The method according to claim 81, wherein the method comprises removing at least one filled prescription from at least one medication holding receptacle and dropping the filled prescription into a trough from which it can be retrieved by a customer in response to information input by a customer.

92. (Previously Presented) The method according to claim 81, wherein the method further comprises charging the customer for the filled prescription prior to dispensing the filled prescription.

93. (Previously Presented) The method according to claim 81, wherein the method further comprises billing a third party for at least a portion of the cost of a prescription once the prescription has been dispensed.

94. (Previously Presented) The method according to claim 81, wherein a plurality of filled prescriptions are disposed in the automated prescription dispensing system, and wherein the filled prescriptions which have not been dispensed are periodically removed from the automated prescription dispensing system by pharmacy personnel.

95. (Previously Presented) A method for dispensing a prescription, the method comprising:

filling a prescription by preparing a container of medication having a patient's name and other prescription information thereon by pharmacy personnel;

pharmacy personnel placing the filled prescription in a medication holding receptacle of a prescription dispensing system having a medication holding area with a plurality of medication holding receptacles;

electronically scanning the prescription to thereby store information about the prescription in an electronic control portion of the prescription dispensing system;

correlating the location of the filled prescription with the information about the filled prescription;

dispensing the filled prescription directly to a customer after the customer inputs information correlated to at least one of the prescription and patient to verify that the customer is authorized to receive the prescription.

96. (Previously Presented) The method according to claim 95, wherein the method comprises charging the customer prior to dispensing the filled prescription.

97. (Previously Presented) The method according to claim 95, wherein the method comprises disposing the prescription dispensing system so that a loading side is disposed on a side of a pharmacy wall accessible to pharmacy personnel, and a dispensing side is disposed where it is accessible to customers.

98. (Previously Presented) The method according to claim 95, wherein the method comprises loading filled prescriptions into the prescription dispensing system on a side opposite the side accessible to customers.

99. (Previously Presented) The method according to claim 95, wherein the method further comprises releasing the prescription from the receptacle so as to allow the customer to retrieve the prescription.

100. (Previously Presented) The method according to claim 99, wherein the prescription dispensing system further comprises a plurality of dispensing doors corresponding to the plurality of receptacles, and wherein the method further comprises selectively actuating one of the plurality of dispensing doors to dispense a filled prescription in response to input by a customer.

101. (Previously Presented) A method for dispensing prescription medication comprising:
transmitting a plurality of prescriptions for a plurality of patients to a pharmacy;
filling the plurality of prescriptions by preparing containers of medication having information specific to a patient disposed thereon;

utilizing an automated prescription dispensing machine located in a pharmacy which is accessible to a pharmacist for loading prescriptions into the dispensing machine and accessible to the public for dispensing prescriptions from the dispensing machine, the prescription dispensing machine comprising a plurality of prescription receiving structures, a control portion, and a customer or patient interface;

entering information regarding each of the plurality of patients into the control portion,
the information being sufficient to identify each of the plurality of patients;

loading the plurality of prescriptions into the dispensing machine by disposing the
prescriptions on or in the plurality of prescription receiving structures;

correlating the location of each of the prescriptions to the identity of the patient
corresponding to the prescription;

allowing a customer to enter information associated with a filled prescription or patient
into the computer controller via the customer or patient interface;

confirming that a prescription for the patient is loaded into the dispensing machine;

receiving payment from the patient for the prescription; and

dispensing the prescription to the patient by moving the prescription from the prescription
receiving structure and dropping the prescription into a dispensing trough separate from the
prescription receiving structure.

102. (Previously Presented) The method of claim 101, wherein the method further
comprises selecting a dispensing machine having a plurality of dispensing doors associated with
the plurality of prescription receiving structures, and wherein the method further comprises
dispensing a prescription to a patient by selectively actuating one of the plurality of dispensing
doors.

103. (Previously Presented) A method for providing a prescription to a patient
comprising:

transmitting the prescription to a pharmacy;

having a pharmacist fill the prescription by preparing container of medication having information specific to the patient;

utilizing an automated dispenser, the dispenser being located at least partially in the pharmacy and having a plurality of prescription receiving structures for holding a plurality of prescriptions, and configured for allowing the patient to receive the prescription without interaction with the pharmacist;

having the pharmacy staff load the prescription into the dispenser by placing the prescription on or in one of the plurality of prescription receiving structures;

sensing the prescription via sensors integral to the automated dispenser to verify the location of the prescription;

associating the location of the prescription with the identity of the patient in a dispenser controller;

allowing a customer to enter information into the dispenser associated with a filled prescription; and

dispensing the prescription to the customer.

104. (Previously Presented) The method of claim 103, wherein the dispenser is located in the wall of the pharmacy.

105. (Previously Presented) The method of claim 103, wherein the method further comprises:

having the pharmacist fill a plurality of prescriptions for a plurality of patients;

loading the plurality of prescriptions into the dispenser by placing the plurality of prescriptions on or in the plurality of prescription receiving structures;

associating each of the plurality of prescriptions with the identity of the patient corresponding to each of the plurality of prescriptions;

dispensing one of the plurality of prescriptions in response to a customer entering sufficient information into the dispenser to identify a patient.

106. (Previously Presented) The method of claim 61, wherein the method further comprises dispensing a plurality of filled prescriptions to a plurality of different customers.

107. (Previously Presented) A method for dispensing prescription medication comprising:
loading a filled prescription comprising a container of medication bearing information specific to a patient into one of a plurality of receiving structures of an automated prescription dispenser, the dispenser being located in a pharmacy so as to be accessible to pharmacy personnel and to pharmacy customers;

sensing the prescription with an electronic sensor to verify the location of the prescription;

receiving, from a customer, identifying information through a control portion of the dispenser information that is sufficient to confirm the identity of the customer;

requiring the customer to enter multiple pieces of information to confirm the identity of the patient and/or prescription;

the dispenser verifying the prescription with the customer; and

dispensing the prescription from automated prescription dispenser to the customer after verification of the prescription.

108. (Previously Presented) The method of claim 107, wherein sensing the prescription with an electronic sensor comprises automatically sensing the prescription within the automated prescription dispenser to verify location.

109. (Previously Presented) The method of claim 107, wherein the method further comprises moving the prescription from the receiving structure to a separate dispensing structure to dispense the prescription to the customer.

110. (Previously Presented) The method of claim 107, wherein sensing the prescription with an electronic sensor comprises scanning the prescription before or during loading to enter information about the prescription into the control portion of the dispenser.

111. (Previously Presented) The method of claim 107, wherein sensing the prescription with an electronic sensor comprises utilizing the sensor to determine if a filled prescription is in a receiving structure.

112. (Previously Presented) The method of claim 107, wherein the method further comprises the dispenser automatically billing a third party for at least a portion of the cost of the prescription.